



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,874	11/14/2003	Jerome Legerton	30682-5	1880

7590 05/02/2005

Peter R. Martinaz, Esq.  
LUCE, FORWARD, HAMILTON & SCRIPPS LLP  
Suite 200  
11988 El Camino Real  
San Diego, CA 92130

EXAMINER

STULTZ, JESSICA T

ART UNIT PAPER NUMBER

2873

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,874

Applicant(s)

LEGERTON ET AL.

Examiner

Jessica T. Stultz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 13-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1103.0904</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of Group 1a, claims 1-12 and 37-44 in the reply filed on April 8, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodur et al.

Regarding claims 1-2, Hodur et al discloses a contact lens comprising (Column 2, line 63-Column 3, line 15, wherein the contact lens is "100", Figure 2): a central portion including an optical zone (Column 2, line 63-Column 3, line 15, wherein the central optical zone is "112", Figure 2); a peripheral portion surrounding the central portion (Column 2, line 63-Column 3, line 15, wherein the peripheral zone includes portions "116", "114", and "118", Figure 2), the peripheral portion having a first thickness (Shown in Figure 2, wherein the first thickness is the thickness of portions "118"); and at least two areas of unequal size located on the peripheral portion (Shown in Figure 2, wherein the two areas are "114" and "116"), with each area having a thickness less than the first thickness (Shown in Figure 2, wherein the thicknesses of sections

Art Unit: 2873

“114” and “116” are less than the thickness of section “118”), wherein the thickness of the at least two zones is unequal (Shown in Figure 2, wherein the thickness of section “116” is less than that of “114”).

Regarding claim 37, Hodur et al discloses a contact lens comprising (Column 2, line 63-Column 3, line 15, wherein the contact lens is “100”, Figure 2): a central portion including an optical zone (Column 2, line 63-Column 3, line 15, wherein the central optical zone is “112”, Figure 2); a peripheral portion surrounding the central portion (Column 2, line 63-Column 3, line 15, wherein the peripheral zone includes portions “116”, “114”, and “118”, Figure 2), the peripheral portion having a first thickness (Shown in Figure 2, wherein the first thickness is the thickness of portion “114”); and at least two areas of unequal size located on the peripheral portion (Shown in Figure 2, wherein the two areas are “116” and “118”), with a first area having a thickness less than the first thickness, and a second area having a thickness greater than the first thickness (Shown in Figure 2, wherein the first area “116” has a thickness less than the thickness of section “114” and the second area “118” has a thickness greater than the thickness of section “114”).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodur et al.

Art Unit: 2873

Regarding claim 8 and 40, Hodur et al discloses a contact lens as shown above wherein the lens can be used to correct for various vision problems (Column 2, lines 18-36, wherein the lens is used for optical correction), but does not specifically disclose that the lens is constructed to include a prescription obtained from a wavefront aberrometer. However, examiner takes judicial notice that it is well known in the art of contact lenses for the lenses to have a prescription obtained from a wavefront aberrometer, for the purpose of determining an accurate prescription for the patient. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the contact lens of lens of Hodur et al to further include a prescription obtained from a wavefront aberrometer since it is well known in the art of contact lenses for the lenses to have a prescription obtained from a wavefront aberrometer, for the purpose of determining an accurate prescription for the patient.

Regarding claims 9 and 41, Hodur et al discloses a contact lens as shown above, but does not specifically disclose that the lens is constructed to include a prescription for presbyopia. However, examiner takes judicial notice that it is well known in the art of contact lenses for the lenses to include a prescription for presbyopia, for the purpose of helping the user accommodate to a change in focus of the user. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the contact lens of Hodur et al to further include a prescription for presbyopia since it is well known in the art of contact lenses for the lenses to include a prescription for presbyopia, for the purpose of helping the user accommodate to a change in focus of the user.

Claims 3-7 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodur et al in view of Sohnges.

Regarding claims 3-7 and 38-39, Hodur et al discloses a contact lens as shown above having a substantially rigid central portion (Column 1, lines 4-7) with a diameter ranging between 4.0 mm - 12.0 mm (Table 2 and Figure 3, wherein the inner diameter of the central portion ranges between 7.3 mm and 8.3 mm), but does not specifically disclose that the lens is a hybrid hard-soft contact lens with a substantially flexible peripheral portion having an outer diameter in the range of 10.0 mm-18.0 mm, wherein a V-shaped junction having an angle of about 10-170 degrees joins the central and peripheral portions. Sohnges teaches of a hybrid hard-soft contact lens (Column 4, line 113-Column 5, line 20, wherein the contact lens shown has two parts, specifically a hard portion "4" and a flexible portion "3", Figures 1-2) comprising: a substantially rigid portion (Column 4, line 113-Column 5, line 20, wherein the contact lens shown has a hard, rigid portion "4", Figures 1-2); and a substantially flexible portion, having an outer diameter in the range of 10.0-18.0 mm (Column 3, lines 5-6 and Column 3, line 120-Column 4, line 20, wherein the lens core is 10 mm and the edge part "3" or "9" is an additional 1 mm, therefore the outer diameter would be 11mm, Figures 1-2), coupled to the substantially rigid portion (Column 4, line 113-Column 5, line 20, wherein the hard, rigid portion "4" is coupled to the flexible portion "3", Figures 1-2); wherein the junction comprises an angled surface comprising a V-shaped junction having an angle of about 10-170 degrees (Shown in Figures 1-2) for the purpose of providing a contact lens that is pleasant to wear, compatible, impermeable to bacteria, and allows an adequate exchange of tear liquid (Column 4, lines 72-78). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the lens of Hodur et al to further be a hybrid hard-soft contact lens and include a substantially flexible peripheral portion with a diameter in the range of 10.0 mm-18.0 mm,

Art Unit: 2873

wherein a V-shaped junction having an angle of about 10-170 degrees joins the central and peripheral portions since Sohnges teaches of a hybrid contact lens comprising: a substantially rigid portion; and a substantially flexible portion having an outer diameter in the range of 10.0-18.0 mm, coupled to the substantially rigid portion; wherein the junction comprises an angled surface comprising a V-shaped junction having an angle of about 10-170 degrees for the purpose of providing a contact lens that is pleasant to wear, compatible, impermeable to bacteria, and allows an adequate exchange of tear liquid.

Claims 10-12 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodur et al in view of Barsky.

Regarding claims 10-12 and 42-44, Hodur et al discloses a contact lens as shown above, but does not specifically disclose that the lens includes a registration mark, specifically a grooved mark, to determine registration error, which can be seen using visible light. Barsky teaches of a contact lens which has a registration mark, specifically a grooved mark, to determine registration error, which can be seen using visible light for the purpose of providing a lens with the correct orientation (Column 16, lines 45-50, wherein the lens includes a visible etched mark). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the lens of Hodur et al to further include a registration mark, specifically a grooved mark, to determine registration error, which can be seen using visible light since Barsky teaches of a contact lens which has a registration mark, specifically a grooved mark, which can be seen using visible light for the purpose of providing a lens with the correct orientation.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vijfvinkel et al is cited as having some similar structure to the claimed invention. Specifically, Vijfvinkel et al discloses a contact lens made of a flexible material with different thicknesses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jess T  
Jessica Stultz  
Patent Examiner  
AU 2873  
April 18, 2005

Georgia Epps  
Supervisory Patent Examiner  
Technology Center 2800